

REMARKS

Claims 1-10 are pending in this application. Claims 1, 2, 4-7 and 9 have been amended by this response. Support for these amendments may be found throughout the specification and specifically on page 3, lines 1-37 and page 4, lines 1-13. Claim 10 has been added by this response. Support for claim 10 can be found throughout the specification and also in claims 1, 3, 5 and 6 as claim 10 includes all features set forth in claims 1, 3, 5 and 6. No new matter has been added by this response.

Rejection of claims 1-3, 5 and 7-9 under 35 U.S.C. 102(b)

Claims 1-3, 5 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Cho (US Patent No. 5,680,176).

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP §2131, citing Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).]

The present arrangement provides a video apparatus. An MPEG encoder receives a first analogue video signal with ancillary information in a given time window and generates, exclusively from the first analogue video signal, on an output a digital video stream based at least partly on the first analogue video signal. An MPEG decoder at least connectable to the output generates a second analogue video signal exclusively from the digital video stream at least when being connected to the output. Control means determine the occurrence of the time window and correspondingly generate a control signal. Selecting means selectively output, based on the control signal, the first analogue video signal, when the time window occurs, and otherwise, the second analogue video signal. The MPEG decoder includes means for synchronising the second analogue video signal to the first analogue video signal.

Cho describes an apparatus for use in a color television system which is capable of automatically controlling the display of caption data contained in a standard video signal on a display device adapted to displaying an image of a wide aspect ratio in a full screen display mode. (See col. 1, lines 66-67 and col. 2, lines 1-4)

Cho neither describes nor suggests “an MPEG encoder … generating, exclusively from said first analogue video signal … a digital video stream based at least partly on said first analogue video signal” or “an MPEG decoder … generating a second analogue video signal exclusively from said digital stream” as recited in claim 1 of the present arrangement. A/D converter 44 of Cho does not perform compression encoding, which is described in the present arrangement. Claim 1 has been amended to clarify that an “MPEG encoder” generates, “exclusively from said first analogue video signal … a digital video stream based at least partly on said first analogue video signal.” Similarly, claim 1 has also been amended to clarify that “an MPEG decoder” generates “a second analogue video signal exclusively from said digital video stream.” Furthermore, the signal input to D/A 52 in Cho is a caption signal and not a “video signal” as described in the present arrangement. Claim 1 has been similarly amended to clarify “analogue video signal” and “digital video stream.” Cho also describes switching circuit 56, which does not directly receive a control signal from D/A 52. Instead, a control signal is indirectly received via D/A 52, which is unlike the present arrangement which provides “an MPEG encoder” which generates “exclusively from said first analogue signal … a digital video stream.” Thus, Cho neither describes nor suggests “an MPEG encoder … generating, exclusively from said first analogue video signal … a digital video stream based at least partly on said first analogue video signal” or “an MPEG decoder … generating a second analogue video signal exclusively from said digital stream” as recited in claim 1 of the present arrangement. Therefore, it is respectfully submitted that the rejection of claim 1 is overcome and should be withdrawn.

Claims 2, 3, 5, 7 and 8 are dependent on claim 1 and are considered patentable for the reasons set forth above regarding claim 1. Therefore, it is respectfully submitted that the rejection of claims 2, 3, 5, 7 and 8 is overcome and should be withdrawn.

Independent claim 9 contains features similar to the ones found in independent claim 1 and is patentable for the reasons set forth above regarding claim 1. Therefore, it is respectfully submitted that the rejection of claim 9 is overcome and should be withdrawn.

Rejection of claim 4 under 35 U.S.C. 103(a)

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Cho (US Patent No. 5,680,176).

The failure of an asserted combination to teach or suggest each and every feature of a claim remains fatal to an obviousness rejection under 35 U.S.C. § 103. Section 2143.03 of the MPEP requires the “consideration” of every claim feature in an obviousness determination. To render a claim unpatentable, however, the Office must do more than merely “consider” each and every feature for this claim. Instead, the asserted combination of the patents must also teach or suggest *each and every claim feature*. *See In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) (emphasis added) (to establish *prima facie* obviousness of a claimed invention, all the claim features must be taught or suggested by the prior art). Indeed, as the Board of Patent Appeal and Interferences has recently confirmed, a proper obviousness determination requires that an Examiner make “a searching comparison of the claimed invention - *including all its limitations* - with the teaching of the prior art.” *See In re Wada and Murphy*, Appeal 2007-3733, *citing In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis in original). “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious” (MPEP §2143.03, citing *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)).

Claim 4 is dependent on claim 1 and is considered patentable for the reasons set forth above regarding claim 1. The Office Action asserts that although Cho does not explicitly describe the features of claim 4, the use of a “CVBS” signal as recited in claim 4 would be obvious to one of ordinary skill in the art.

However, as described above, Cho neither teaches or suggests “an MPEG encoder ... generating, exclusively from said first analogue video signal ... a digital video stream based at least partly on said first analogue video signal” or “an MPEG decoder ... generating a second analogue video signal exclusively from said digital stream” as recited in claim 1 of the present arrangement. Thus, since claim 4 is dependent on claim 1, claim 4 is patentable for the same reasons as claim 1. Therefore, it is respectfully submitted that the rejection of claim 4 is satisfied and should be withdrawn.

Claim 6 has been indicated as allowable if rewritten in independent form including all limitations of the base claim and any intervening claims. Independent claim 10 includes the features of claims 1, 3, 5 and 6. Since claim 6 has been indicated as allowable if rewritten in independent form, it is respectfully submitted that independent claim 10 is allowable.

Additionally, in view of the above remarks regarding claim 1, it is respectfully submitted that claim 1 is patentable and thus claim 6 is patentable based on its dependency on claim 1.

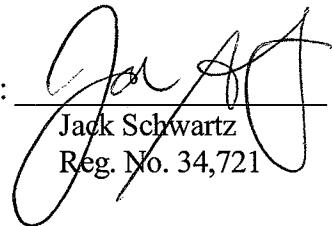
Having fully addressed the Examiner’s rejections, it is believed that, in view of the preceding amendments and remarks, this application stands in condition for allowance. Accordingly then, reconsideration and allowance are respectfully solicited. If, however, the Examiner is of the opinion that such action cannot be taken, the Examiner is invited to contact the applicant’s attorney at the phone number below, so that a mutually convenient date and time for a telephonic interview may be scheduled.

No other fee is believed due. However, if an additional fee is due, please charge the fee to Deposit Account 07-0832.

Respectfully submitted,
Frank Dumont et al.

By:

Jack Schwartz
Reg. No. 34,721

A handwritten signature in black ink, appearing to read "Jack Schwartz", is written over a horizontal line. The line is slightly curved and ends in a flourish. Below the signature, the text "Reg. No. 34,721" is printed.

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